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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/905,510  | 07/13/2001  | Dan Vassilovski      | 010275              | 3380             |
| 23696   | 7590        | 04/27/2005           | EXAMINER            |                  |
| Qualcomm Incorporated<br>Patents Department<br>5775 Morehouse Drive<br>San Diego, CA 92121-1714 |             |                      | DUONG, DUC T        |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2663                |                  |

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/905,510

Applicant(s)

VASSILOVSKI ET AL.

Examiner

Duc T. Duong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,9,10,12,14,16-25,27,29-32,34-36 and 38-57 is/are rejected.
- 7) ☒ Claim(s) 4-8,11,13,15,26,28,33,37,58 and 59 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/24/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 12 is objected to because of the following informalities: In the claim, line 5 there appear a typo error in the word "IP", it should be --SIP-- instead. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 21, the claim defines neither a method nor an apparatus. The claim as a whole is neither a definition of a method nor of an apparatus but is instead a hybrid of the two; it, therefore, does not define the invention in the manner contemplated by the second sentence of 35 U.S.C. Sec. 112 (see *In re Oakley*, 1935 C.D. 198, 454 O.G. 536, 73 F.2d 934, 24 USPQ 75).

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-3, 9, 10, 12, 14, 16-25, 27, 29-32, 34-36, 38, 39, 40-46, 49, 52, and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee et al (US Patent 6,807,173 B1).

Regarding to claim 1, Lee discloses a system comprising at least one Session Initiation Protocol (SIP) header containing information (fig. 2A col. 3 lines 24-26) derived at least in part from an over-the-air (OTA) protocol message from a wireless communication device 40 (fig. 1 col. 2 lines 39-42) and at least one telephony infrastructure component 42 receiving the information for use thereof in establishing communication with the wireless communication device 40 (fig. 1 col. 2 lines 42-47).

Regarding to claims 2 and 3, Lee discloses the OTA protocol message is a code division multiple access CDMA initiation request message representing call set-up parameters (fig. 1-2A col. 2 lines 39-42).

Regarding to claims 9 and 10, Lee discloses the header is part of an SIP Invite Request message or Register Request message (fig. 2A col. 5 table II).

Regarding to claim 12, Lee discloses a method for facilitating communication between a wireless communication device 40 transmitting information using an over-

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the-air (OTA) protocol and a telephony infrastructure 42 using IP protocol to communicate information within the infrastructure (fig. 1 col. 2 lines 56-63), comprising adding data (y-encryption) in at least one SIP message header representing at least one OTA network parameter (col. 6 table III; the token header field y read on the data representing the OTA parameter).

Regarding to claim 14, Lee discloses the parameter includes a station classmark z (col. 6 table III; the token header field z read on the station classmark).

Regarding to claim 16, Lee discloses the parameter represents whether a signaling message encryption is supported (col. 6 table III; the token header field y indicate encryption capability).

Regarding to claim 17, Lee discloses the parameter includes a MOB\_TERM status ttl (col. 6 table III; the ttl parameter read on the MOB\_TERM status).

Regarding to claims 18 and 19, Lee discloses the message header is a portion of a Session Initiation Protocol (SIP) Invite Request message or Register Request message (col. 5 lines table II).

Regarding to claim 20, Lee discloses the OTA protocol is a CDMA protocol (col. 2 lines 39-42).

Regarding to claim 21, Lee discloses a wireless communication device infrastructure 10 transmitting information internally to the infrastructure using Internet Protocol (IP) messages (fig. 1 col. 2 lines 56-63), at least one message being sent from a virtual IP endpoint 42 within the infrastructure 10 and representing communication

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from a wireless communication device 40 transmitting information using an over-the-air (OTA) protocol different from IP (col. 2 lines 29-42).

Regarding to claim 22, Lee discloses the information is transmitted in at least one header of at least one session initiation protocol (SIP) message (fig. 2A col.3 lines 18-23).

Regarding to claims 23-25, Lee discloses the communication from the wireless communication device 40 is transmitted in an OTA protocol message using CDMA call set-up parameters (col. 2 lines 39-42).

Regarding to claim 27, Lee discloses the information includes a station classmark z (col. 6 table III; the token header field z read on the station classmark).

Regarding to claim 29, Lee discloses the information represents whether a signaling message encryption is supported (col. 6 table III; the token header field y indicate encryption capability).

Regarding to claim 30, Lee discloses the parameter includes a MOB\_TERM status ttl (col. 6 table III; the ttl parameter read on the MOB\_TERM status).

Regarding to claims 31 and 32, Lee discloses the message header is a portion of a Session Initiation Protocol (SIP) Invite Request message or Register Request message (col. 5 lines table II).

Regarding to claim 34, Lee discloses a method, comprising using extended session initiation protocol (SIP) headers to transmit over-the-air (OTA) protocol parameters within an infrastructure 10 using at least one voice over Internet Protocol VOIP (fig. 1 col. 2 lines 39-42), such that a protocol other than the VOIP need not be

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used within the infrastructure to effect call set-up between a wireless communication device 40 and another communication device 12 via the infrastructure 10 (fig. 1 col. 2 lines 56-67).

Regarding to claim 35, Lee discloses the OTA protocol is a code division multiple access CMDA (col. 2 lines 39-42).

Regarding to claim 36, Lee discloses the parameter includes a station classmark z (col. 6 table III; the token header field z read on the station classmark).

Regarding to claim 38, Lee discloses the parameter represents whether a signaling message encryption is supported (col. 6 table III; the token header field y indicate encryption capability).

Regarding to claim 39, Lee discloses the parameter includes a MOB\_TERM status ttl (col. 6 table III; the ttl parameter read on the MOB\_TERM status).

Regarding to claims 40 and 41, Lee discloses the message header is a portion of a Session Initiation Protocol (SIP) Invite Request message or Register Request message (col. 5 lines table II).

Regarding to claims 42-45, Lee discloses the header includes a "from" line having a uniform resource locator (URL) derived at least in part from a communication device number of the wireless communication device 40 (fig. 2A col. 8 line 27).

Regarding to claims 46, 49, 52, and 55, Lee discloses the SIP header is an SIP Content Disposition header having defined types (z-authorization, y-encryption, i-call id) corresponding to OTA parameters (col. 4 lines table I).

***Claim Rejections - 35 USC § 103***

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 47, 48, 50, 51, 53, 54, 56, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Syrjala et al (US Publishing 2004/0078349 A1).

Regarding to claims 47, 48, 50, 51, 53, 54, 56, and 57, Lee discloses all the limitations with respect to claims 1, 12, 21, and 34 including support content types such as applications/sdp (col. 6 table III). However, Lee fails to teach for the header includes a short message service SMS indicating that a message body contains OTA SMS data (claims 47, 50, 53, and 56) or an e-mail media type indicating that a message body contains OTA e-mail text data (claims 48, 51, 54, and 57). However, Syrjala discloses a SIP standards supporting content type such as text (SMS) and e-mail using MIME definition indicated in the header (page 1 paragraph 0017). Thus, it would have been obvious to a person of ordinary skill in the art to employ such MIME definition in the header of SIP as taught by Syrjala in Lee's system a proper decoding of the content types.

***Allowable Subject Matter***

8. Claims 4-8, 11, 13, 15, 26, 28, 33, 37, 58, and 59 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



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The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach or make obvious the step of or means for **“the parameters are related to the OTA protocol and are not related to voice over Internet Protocol (VOIP) communication within the infrastructure”**, when such parameters are considered within the specific structure of the method recited in claims 4 and 13 or the device recited in claim 26. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach or make obvious the step of or means for **“the header is part of an SIP message from a virtual IP endpoint, and the information represents communication from a non-IP enabled CDMA communication device”**, when such header and information are considered within the specific structure of the method recited in claim 11 or the device recited in claim 33. The prior art of record fails to teach or make obvious the step of or means for **“the classmark represents at least wireless telephone power”**, when such classmark is considered within the specific structure of the method recited in claims 15 and 37 or the device recited in claim 28. The prior art of record fails to teach or make obvious the step of or means for **“sending a second SIP Invite message containing only parameters required for SIP VOIP communication and excluding CDMA-specific parameters not required for SIP VOIP communication”**, when the sending is considered within the specific structure of the method recited in claims 58 and 59.

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**Conclusion**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc T. Duong whose telephone number is 571-272-3122. The examiner can normally be reached on M-F (9:00 AM-5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Q. Ngo can be reached on 571-272-3139. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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DD

  
RICKY NGO  
PRIMARY EXAMINER

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